

Attorney's Docket No. 011496/236625

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/902,475 (Reissue) Confirmation No.: 7468
Applicant(s): Dominique Briere
Filed: July 9, 2001
Art Unit: 1791
Examiner: Davis, Robert B.
Title: BLOW MOLDING DEVICE FOR PRODUCING THERMOPLASTIC
CONTAINERS

Docket No.: 011496/236625
Customer No.: 00826

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Commissioner for Patents
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REPLY BRIEF UNDER 37 CFR § 41.41

This Reply Brief is filed in response to the Examiner's Answer filed October 20, 2008.

1. ***Real Party in Interest.***

Contained in Appeal Brief.

2. ***Related Appeals and Interferences.***

The parent reissue application, Application No. 09/553,413 now issued as RE39,769, was the subject of an appeal. The Decision on Appeal (Appeal No. 2006-0123) was first issued on February 24, 2006 and a corrected version was mailed on May 11, 2006. The panel deciding the appeal consisted of Administrative Judges Owen, Watz and Franklin.

3. ***Status of Claims.***

The continuation reissue application on appeal was originally filed with Claims 1-33 with an accompanying preliminary amendment canceling Claims 1-21 and 32-33. During prosecution of the continuation application, new Claims 32-51 were added with new Claims 32-44 eventually being canceled. Accordingly, Claims 22-31 and Claims 45-51 remain pending in the continuation reissue application.

Since the Appeal Brief was filed, the Examiner has withdrawn the rejection of Claims 22-31 and 45-47 in view of a supplemental amendment filed November 29, 2007. Accordingly, Appellants withdraw these claims from consideration on this appeal.

Claims 48-51 remain the subject of this appeal.

Claims 48-50 stand twice rejected under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered during prosecution of the application for patent from which U.S. Patent No. 5,968,560 issued.

Claim 51 stands once rejected under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered during prosecution of the application for patent from which U.S. Patent No. 5,968,560 issued.

4. ***Status of Amendments.***

No amendment after final has been filed.

5. ***Summary of Claimed Subject Matter.***

Contained in Appeal Brief.

6. ***Grounds of Rejection to be Reviewed on Appeal.***

Contained in Appeal Brief.

7. ***Argument.***

Response to the Examiner's Answer

In the Examiner's Answer, the Examiner raises the issue as to whether the fact that the reissue claims are subcombinations renders the recapture rejection moot. The Appellants

contend that the Board provided guidance on how to analyze subcombination claims in the related Appeal. *See* Appeal No. 1006-0123 (Issued May 11, 2006). Specifically, the Board reasoned that “the appellants are not recapturing subject matter *pertaining to the claimed mold assembly* that was surrendered to get the ‘560 patent issued,” where the “claimed mold assembly” was a subcombination of Claim 1 from the issued ‘560 patent. *Id.* at p. 5. Thus, the proper inquiry for the mold shell assembly subcombination claims (*i.e.* Claims 48-51) is whether the subject matter surrendered to get the ‘560 patent issued pertaining to the mold shell assembly has been recaptured. The Appellants contend that this is not the case.

The Board found in the earlier appeal that the shape limitation explicitly added to the mold carriers implicitly limited the shape of the shell holders to be capable of being supported by mold carriers in the form of enveloping structures. *Id.* As can be seen in the claim language of Claim 1 of the ‘560 patent provided below, the relationship between the shape of the mold carriers and the mold shell holders is substantially the same as the relationship between the mold carriers and the mold shells, *i.e.* the mold carriers support both the shell holders and the shells. As illustrated by the claim language of Claim 1, an associated mold carrier supports a half-mold, which comprises a shell holder and a mold shell. The amendment added to gain allowance of the ‘560 patent is shown in bold text.

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including

at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) **which are made in the form of enveloping structures and** which can move one with respect to the other, characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23), the shell (7) and

the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections

for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

As clearly recited in the '560 patent Claim 1, each of the half-molds is "respectively supported by a mold carrier which is made in the form of an enveloping structures." The half-molds themselves comprise "a shell holder (9)" and "a shell (7)." Since the half-molds are supported by the mold carriers, logic dictates that the components of the half-molds (*i.e.* the shell holders and the shells) must likewise be supported by the mold carriers. As noted above, the Board found that the shell holders were implicitly limited to be capable of being supported by mold carriers made in the form of enveloping structures. *Id.* Applying the Board's same logic, the other component of the half-mold, *i.e.* the shells, must have also been implicitly limited as to be capable of being supported by mold carriers in the form of enveloping structures. *See id.* Appellants firmly disagree with the Examiner on this point.

In analyzing the rejected subcombination claims in the related appeal, the Board reasoned that the shell holders were structurally limited by language in the claims requiring the shell holders to be capable of being supported by mold carriers in the form of enveloping structures. *Id.* The result was a finding of no recapture for the mold assembly subcombination claims. *Id.* Appellants contend that the same type of implicit limitation has been retained in the shell assembly subcombination claims currently on appeal (*i.e.* Claims 48-51). For example, Claim 48 requires:

said mold shells being configured to be supported by mold carriers made in the form of enveloping structures via interposed mold shell holders, said mold shell holders being shaped to be supported by said mold carriers made in the form of enveloping structures

Because the shell assembly subcombination claims retain the limitations placed on the subcombination by the limitation added during prosecution of the '560 patent, the new claims do not recapture subject matter *pertaining to the claimed shell assembly* that was

surrendered to get the '560 patent issued. *See id.* Thus, the recapture rejection is improper.

8. ***Claims Appendix.***

Contained in Appeal Brief.

9. ***Evidence Appendix.***

Contained in Appeal Brief

10. ***Related Proceedings Appendix.***

Contained in Appeal Brief

CONCLUSION

In view of the foregoing arguments, Appellants submit that Claims 48-51 do not recapture subject matter surrendered during prosecution of the original application maturing into U.S. Patent 5,968,560. A decision from the Board of Patent Appeals and Interferences reversing the rejections of the pending claims is therefore earnestly solicited.

Respectfully submitted,



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